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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,932	01/20/2000	Richard Alan Fiedotin	10160-02-999	3747
24341	7590	07/14/2006	EXAMINER	
MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			COBANOGLU, DILEK B	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/487,932	Applicant(s) FIEDOTIN ET AL.	
	Examiner Dilek B. Cobanoglu	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-88 is/are pending in the application.
- 4a) Of the above claim(s) 67-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/28/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 45-66 in the reply filed on 04/20/2006 is acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 45-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falchuk et al (hereinafter Falchuk) (U.S. Patent No. 6,256,613) in view of Edelson et al. (hereinafter Edelson) (U.S. Patent No. 5,737,539).

A. As per claim 45, Falchuk discloses a method for distributing medical information to physicians, the method comprising:

- i. Identifying a physician from a database of multiple physicians (Falchuk; col. 6, lines 1-10);
 - ii. Generating an interactive message comprising medical information customized to said identified physician (Falchuk; col. 6, lines 11-17);
- Falchuk fails to expressly teach the receiving a communication signal from and transmitting said interactive message to a handheld computing device, per se, since it appears that Falchuk is more

directed to a personal computer (Falchuk; col. 2, lines 11-21).

However, this feature is well known in the art, as evidenced by Edelson.

In particular, Edelson discloses "receiving a communication signal from and transmitting said interactive message to a handheld computing device" (Edelson; col. 7, lines 44-49, col.44, lines 16-23, 33-36 and Fig. 16).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Edelson with the motivation of having small size and enabling to exchange data with host systems without the cost or inconvenience of hard wiring (Edelson; col. 3, lines 32-44).

B. As per claim 46, Falchuk discloses the method of claim 45, wherein said identifying is based on information selected from the group consisting of: a practice of the physician; a number of prescriptions written by said physician; a Drug Enforcement Agency number of said physician, a medical education number said physician, and or any combination of he aforementioned (Falchuk; col. 3, lines 47-52 and col. 5, lines 48-54).

C. As per claim 47, Falchuk discloses the method of claim 45, wherein said identifying is based on a medical education number of said physician (Falchuk; col. 3, lines 47-52 and col. 5, lines 48-54).

D. As per claim 48, Falchuk discloses the method of claim 45, further comprising, after said identifying, examining a profile of said identified physician, wherein said interactive message is customized based on said physician's profile (Falchuk; col. 6, lines 1-10).

E. As per claim 49, Falchuk discloses the method of claim 45, wherein the interactive message includes an interactive question directed to the physician (Falchuk; col. 5, lines 35-47).

F. As per claim 50, Falchuk discloses the method of claim 45, wherein the interactive message includes a question asking the physician if the physician would like further information on a certain medical topic (Falchuk; col. 5, lines 35-47).

G. As per claim 51, Falchuk discloses the method of claim 45, wherein the interactive message includes an inquiry whether said physician wishes to receive Continuing Medical Education (CME) (Falchuk; col. 5, lines 48-58).

The obviousness of modifying the teaching of Falchuk to include a handheld computing device (as taught by Edelson) is as addressed above in the rejection of claim 45 and incorporated herein.

H. As per claim 52, Falchuk discloses the method of claim 51, wherein the Continuing Medical Education includes educational materials or multiple choice exams (Falchuk; col. 5, lines 48-58).

- I. As per claim 53, Falchuk discloses the method of claim 45, further comprising, after said transmitting, receiving a response from said physician (Falchuk; col. 5, lines 35-47).
- J. As per claim 54, Falchuk discloses the method of claim 53, further comprising, sending further medical information to said physician based on said response (Falchuk; col. 6, lines 10-27).
- K. As per claim 55, Falchuk discloses the method of claim 45, wherein the interactive message includes an inquiry whether said physician wishes to receive Continuing Medical Education (CME) (Falchuk; col. 5, lines 48-58), and said method further comprises, after said transmitting, receiving a response from said physician and transmitting CME educational materials or multiple choice exams if said response indicated that said physician wishes to receive Continuing Medical Education (CME) (Falchuk; col. 5, lines 48-67).

The obviousness of modifying the teaching of Falchuk to include a handheld computing device (as taught by Edelson) is as addressed above in the rejection of claim 45 and incorporated herein.

- L. As per claim 56, Falchuk discloses the method of claim 45, wherein said generating further comprises associating an expiration date with said interactive message expires after a predetermined time (Falchuk; col. 4, lines 53-61).
- M. As per claim 57, Falchuk discloses the method of claim 45, wherein said generating further comprises associating an expiration date with said interactive

message, such that said interactive message expires after a predetermined time and is thereafter removed (Falchuk; col. 4, lines 53-61).

The obviousness of modifying the teaching of Falchuk to include a handheld computing device (as taught by Edelson) is as addressed above in the rejection of claim 45 and incorporated herein.

N. As per claim 58, Falchuk discloses the method of claim 45, wherein said interactive message is configured to be automatically displayed to said physician once downloaded (Falchuk; col. 6, lines 24-27, lines 28-43).

The obviousness of modifying the teaching of Falchuk to include a handheld computing device (as taught by Edelson) is as addressed above in the rejection of claim 45 and incorporated herein.

O. As per claim 59, 61 and 62, Falchuk discloses the method of claim 45.
(Falchuk; abstract, col. 6, lines 1-10)

The obviousness of modifying the teaching of Falchuk to include a handheld computing device (as taught by Edelson) is as addressed above in the rejection of claim 45 and incorporated herein.

In addition, Examiner would like to submit that all the limitations disclosed in claims 59, 61 and 62 are the characteristics of a handheld computing device; such as receiving a synchronizing signal from said handheld computing device, store a set maximum amount of message at any one time and prioritizing the interactive message by a category selected from

the group consisting of: an expiration date, importance and urgency and they are described in Edelson; col. 10, line 55 to col. 11, line 4.

P. As per claim 60, Falchuk discloses the method of claim 45, further comprising repeating said generating and transmitting steps for multiple interactive messages (Falchuk; col. 3, lines 27-31).

Q. As per claim 63, Falchuk discloses the method of claim 45, further comprising:

i. Storing medical data in a database (Falchuk; col. 2, lines 38-46, col. 3, line 53-col.4, line 3); and

ii. Communicating at least some of said medical data from said database (Falchuk; col. 3, lines 53- col. 4, line 3, col. 5, lines 48-67)

The obviousness of modifying the teaching of Falchuk to include a handheld computing device (as taught by Edelson) is as addressed above in the rejection of claim 45 and incorporated herein.

R. As per claim 64, Falchuk discloses the method of claim 63, further comprising, before said storing, aggregating said medical data from multiple sources (Falchuk; col. 2, lines 22-46).

S. As per claim 65, Falchuk discloses the method of claim 64, wherein said aggregating step further comprises collecting

Falchuk fails to expressly teach medical data from a group consisting of: formulary data, pharmacopia data, and any combination of the aforementioned, per se, since it appears that Falchuk is more directed to a

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medical data consisting of medical journals, tutorials (Falchuk; col. 3, line 53-col. 4, line 3). However, this feature is well known in the art, as evidenced by Edelson.

In particular, Edelson discloses "medical data from a group consisting of: formulary data, pharmacopia data, and any combination of the aforementioned" (Edelson; col.8, lines 11-16).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Edelson with the motivation of permitting enhancement of the quality of prescribing decisions (Edelson; abstract).

T. As per claim 66, Falchuk discloses the method of claim 63, wherein said communicating said medical data further comprises:

- i. Receiving a request for medical data (Falchuk; col. 2, lines 11-21);
- ii. Responding to the request by sending at least a portion of said medical data (Falchuk; col. 2, lines 22-37).

The obviousness of modifying the teaching of Falchuk to include a handheld computing device (as taught by Edelson) is as addressed above in the rejection of claim 45 and incorporated herein.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach "Prescription management system" 5,845,255 A, "System and method for improving compliance of a medical regimen" 6,305,377 B1, "Portable ultrasound imaging system" 5,839,442 A, "Method and apparatus for electronically accessing and distributing personal health care information and services in hospitals and homes" 5,867,821 A, "Digital signal organized in self-contained data containers, especially for data transmission to selective call receivers" 5,875,178 A.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.
6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DBC

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06/28/2006


C. LUKE GILLIGAN
PATENT EXAMINER